This section of the Guidelines goes on to state that:

"If a physical transformation occurs outside the computer, it is not necessary to claim the practical application. A disclosure that permits a skilled artisan to practice the claimed invention, i.e., to put it to practical used, is sufficient."

Thus, to be statutory, the process claims must satisfy either the first **or** second requirement. In this case, it has been asserted that claim 1 is non-statutory because it fails the second requirement. However, the Applicants respectfully submit that the process in claim 1 is statutory because it satisfies at least the first requirement.

Claim 1 recites a method that includes producing marketing analytics and "presenting the marketing analytics in at least one of a plurality of selectable forms to allow a user to make a decision." In other words, a user can select an analytic and make a decision based on one of the selected analytics. In one embodiment, a presentation engine is used to display a variety display choices (see claim 5) and allows the user to select one ore more analytics (e.g. as recited in claim 7, utility analytic, a trend analytic, an attribute importance analytic, a competitive advantages and opportunities analytic, and an improvement opportunities analytic). A user can make a decision based on a selected analytic such as evaluating the utility of various brands. (See page 15, lines 18 to page 16, line 15 of the application) Furthermore, once an analytic is selected, a simulation involving a "what-if" scenario can be selected and executed providing the user with additional insights for making business decisions. (See claim 6, and page 16, lines 16-24 of the application) Thus, the method includes a selection process resulting in "a physical transformation outside the computer for which a practical application in the technological arts is disclosed in the specification" as required under the Guidelines. For the reasons explained above, claim 1 is statutory because it satisfies the Guidelines.

Moreover, claim 1 is statutory subject matter for the following reasons. Claim 1 recites a method of doing business. The method includes "producing marketing analytics" and "presenting the marketing analytics in at least one of a plurality of selectable forms to allow a user to make a decision." The tangible result includes providing a plurality of selectable forms allows a user to select from the analytics and make a decision based on a selected analytic. The method hardly may be considered to "merely manipulate an abstract idea."

"The use of the expansive term 'any' in Section 101 represents Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in Section 101 . . . [T]he Supreme Court has acknowledged that Congress intended Section 101 to extend to 'anything under the sun that is made by man' . . . Thus it is improper to read into Section 101 limitations as to the subject matter that may be patented . . ." In Re Alappat, 33 F.3d 1526 (Fed. Cir. 1994)(citations omitted); see also, State Street Bank & Trust v. Signature Financial Services, 149 F.3d 1368, 1379 (Fed. Cir. 1998). The Supreme Court has identified three categories of subject matter that are unpatentable, namely, "laws of nature," "natural phenomena" and "abstract ideas." Diamond v. Diehr, 450 U.S. 175, 185 (1981).

"The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to . . . but rather on the essential characteristics of the subject matter, in particular, its practical utility." State Street Bank, 149 F.3d at 1386. We respectfully assert that claim 1 represents a practical application resulting in a patentable "useful, concrete and tangible result" of gathering marketing information. Alappat, 33 F.3d at 1544. Thus, the Applicants request withdrawal of the 35 U.S.C. § 101 rejection of claim 1 and dependent claims 2-7.

Claim 8 recites "[a]n apparatus comprising ... a memory; and a processor coupled to the memory, wherein the processor is configured to.." To overcome the rejection, the Office Action suggests that claim 8 incorporate techniques limited to the technological arts such as a computer system. Applicants respectfully point out that claim 8 includes techniques limited to the technological arts by reciting an apparatus that includes a computer system (i.e. a memory and a processor). Thus, the Applicants request withdrawal of the 35 U.S.C. §101 rejection of claim 8 and dependent claims 9-14 should be allowable.

Claim 15 recites "[a]n article comprising a computer-readable medium that stores executable instructions for causing a computer system to ...." To overcome the rejection, the Office Action suggests that claim 15 incorporate techniques limited to the technological arts such as a computer system. Applicants respectfully point out that claim 15 includes techniques limited to the technological arts by reciting a "Beauregard" type claim that includes an article for storing instructions to be executed on a computer system. Thus, the Applicants request withdrawal of the 35 U.S.C. §101 rejection of claim 15 and dependent claims 16-21.

Claim 34 recites "[a] tool that includes ... an analytic engine ... and a presentation engine ..." To overcome the rejection, the Office Action suggests that claim 34 incorporate techniques limited to the technological arts such as a computer system. But claim 34 includes techniques limited to the technological arts by reciting components associated with a computer system. That is, claim 34 recites a tool that includes an analytic engine and a presentation engine representing components well known in the computer arts. Thus, the Applicants request withdrawal of the 35 U.S.C. §101 rejection claim 34 and dependent claims 35-37.

Thus, in view of the above remarks, the Applicants respectfully request withdrawal of all of the 35 U.S.C. § 101 rejections.

Claim Rejections – 35 USC § 103

Claims 1-37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over International Application No. (PCT/US99/10565 ("the '096 Publication") in view of U.S. Patent No. 5,041,972 ("Frost").

Claim 1 recites a method that includes "receiving at least conjoint survey data concerning consumer experience with a brand" and "processing the conjoint survey data to produce marketing analytics." For example, in one embodiment, conjoint survey data is described in the following manner:

> Conjoint survey data is based on a statistical technique known as conjoint analysis. The technique is based on adapting questions based on a consumer's response over time. The technique also relies on a series of dynamic comparison questions which enables a respondent participating in the conjoint survey to make tradeoffs among product or service attributes. For example, an online financial services company may offer services such as free market research and low fee online trading. The respondent may be asked questions regarding the attribute "free market research" and whether it is important relative to the attribute "low fee online trading."
>
> (See page 9, lines 15- 26 of the present application)

The technique produces marketing analytics based on "conjoint survey data" which can provide the user with the ability to track and measure the strength of brand experience, thus

allowing the user to make decisions regarding the brand, both online and offline. (See page 4, lines 6-10 of the present application)

The '096 Publication discloses a survey system and method that includes delivering surveys over the Internet to customers and receiving survey data from the customer. (See page 3, lines 6-8 of the '096 application) As recognized by the Examiner, the '096 Publication discloses an example of a survey question that asks a customer which foods the customer likes from a list of 50 different foods. (See page 15, lines 18-20 of the '096 application) The customer can check 0-49 of these selections to create a multi-nominal that is typically stored as a Boolean vector. (Id.) Although such a technique may represent an example of a survey, it is not equivalent to "conjoint survey data concerning consumer experience with a brand." Thus, the '096 Publication fails to teach or suggest the invention as recited in claim 1.

Frost discloses a method of evaluating a consumer response that includes conducting interviews to obtain emotional, rational and personality descriptors of functional related items. (See Abstract) Although such a technique may represent a method of evaluation, it is not equivalent to receiving or processing "conjoint survey data concerning consumer experience with a brand." Thus, the Frost patent fails to teach or suggest the invention as recited in claim 1.

Moreover, the '096 Publication discloses the use of a Web browser to request a survey via the Internet 12 from the Web survey 20, and then having the customer fill out the survey. (See page 16, lines 6-8 of the '096 application) Although such a technique may represent an example of processing a survey, it is not equivalent to "processing the conjoint survey data" as recited in claim 1. Thus, the '096 Publication and the Frost patent, alone or in combination, fails to teach or suggest the invention as recited in claim 1.

In view of the above remarks, the Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claim 1 as well as dependent claims 2-7.

Claim 8 recites an apparatus configured to perform the method of claim 1. As explained above, claim 1 is distinct from the prior art. Thus, claim 8 and dependent claims 9-14 should be allowable for at least the same reasons as claim 1.

Likewise, claim 15 recites an article configured to include instructions to perform the method of claim 1. Thus, claim 15 and dependent claims 16-21 should be allowable for at least the same reasons as claim 1.

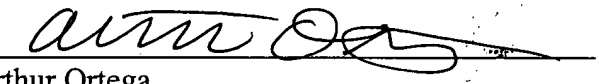
Similarly, claims 22, 26, 30, and 34 recite subject matter that includes receiving and processing "conjoint survey data." Thus, claims 22, 26, 30, and 34 as well as their respective dependent claims should be allowable for at least the same reasons as applicable to claim 1.

Consequently, the applicants respectfully request withdrawal of the 35 U.S.C. § 103 rejections of claims 1-37.

Applicant asks that all claims be allowed. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 2/12/03



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